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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,073	06/30/2000	CONNIE T MARSHALL	ODS-9	2964

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EXAMINER

ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/609,073

Applicant(s)

MARSHALL ET AL. *CM*

Examiner

Steven Ashburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 37-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 37-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121. *MS* **MARK SAGER**
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The references listed in the information disclosure statement filed September 23, 2002 (paper no. 12) were not attached to the file and could not be located. The examiner will generate copies of the U.S. patent documents but requests the applicant submit new copies of the foreign patent documents listed on page five of the information disclosure statement, *and especially any translations thereof. mal*

Double Patenting

Claims 1-19 and 37-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over either claims 1-59 of *Brenner*, U.S. Patent 6,004, 211 (Dec. 21, 1999) (hereinafter "*Brenner '211*") or claims 1-132 of *Brenner*, U.S. Patent 5,830,068 (Nov. 3, 1998) (hereinafter "*Brenner 068*") each in view of Lawler, U.S. Patent 5,805,763 (Sep. 8, 1998).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Response to Arguments

Applicant's arguments filed September 23, 2002 have been fully considered but they are not persuasive.

First, the Applicant asserts that the examiner has failed to consider the applicant's claims as a whole because each feature of the claims was considered in isolation. The examiner respectfully disagrees. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of

Art Unit: 3714

the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). A discussion of the combination of art is provided below. See *infra*. Here, the applicant's claims were broken down into an organized list to provide evidence of each and every element. Most notably, the Applicant merely asserts that the claims were considered in isolation, however the Applicant neither presents evidence thereof nor suggests what features were left unappreciated by the rejection. Consequently, the argument is unpersuasive.

Second, in regards to claims 1-18 and 37-47, the Applicant contends the examiner has failed to provide a motivation to combine the references because the motivation was based on improper hindsight. In response to applicant's argument, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The standard of patentability is what the prior art taken as a whole at a time prior to the invention suggests to an artisan. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, *Brenner '211* and *Brenner '068* claim off-track wagering systems having an interactive, menu-based user interface allowing users to view race information, place wagers, view race videos from remotely located terminals. See, e.g., *Brenner '068*, fig. 36-49; col. 2:30-18. For example, Claim 1 of *Brenner '068* describes a wagering system with features allowing a user to perform the following activities:

- a. Interact with a data facility to receive racing data wherein the racing data provides video signals.
- b. Interact with a user terminal providing input means for receiving video signals and racing data; a monitor; display and control circuitry for displaying racing data on the monitor; user input

Art Unit: 3714

means for receiving wagering data; and transaction data communication circuitry that transmits wager data.

Moreover, claim 13 describes features allowing a user to:

- a. Interact with means for present in the monitor a menu option of selecting a racetrack for which it is desired to place wagers.
- b. Interact with means for presenting the monitor a menu option of selecting a race track for which I is desired to place a wager
- c. Interact with means for presenting on the monitor a menu option of selecting a wager type.
- d. Interact with means for presenting on the monitor a menu option of selection wagers.

Additionally, claims 100 and 120 describe a system ^{providing} ~~proving~~ a process allowing a user to: not

- a. Interact with a system to receive racing data.
- b. Interact with the system to maintain a user account.
- c. Interact with the system to receive racing data from a wagering data facility with a racing data interface
- d. Interact with the system to be supplied real-time racing videos of at least one live event.
- e. Interact with the system for setting a video recorder to record a predetermined on of the racing videos.

Hence, the claims describe an interactive, automated wagering system in which a user inputs and receives data through a terminal displaying menu options on a monitor thereby allowing the user to select wagering options including recording racing videos.

Lawler discloses an analogous system in which users interact with a terminal displaying menu options on a monitor to select program options including recording videos. *See fig. 1, 4(a)(b), 5.* The reference teaches that the practice of recording video programs is a common way to increase the

Art Unit: 3714

enjoyment and flexibility of viewing videos. *See col. 1:8-23*. Additionally, recording allows for repeated viewing. *See id.* Accordingly, *Lawler* teaches simplifying the recording of video programs through an interactive, menu-based user interface by automatically providing the option to record videos upon selection by the user. *See fig. 1, 4-10; col. 1:33-2:35, 7:10-18; 10:42-11:6*.

In sum, *Brenner '211* and *Brenner '068* teach an interactive, menu-based wagering system in which users view and select wager information including to option to record videos. *Lawler* teaches an interactive, menu-based system in which users view and select program information. *See fig. 1, 4-10*. The reference suggests automatically providing the option to record a program selected from the interactive menu to simplify the recording process. *See id.* Consequently, the combination of either *Brenner '211* and *Brenner '068* with *Lawler*, when taken as a whole, suggests to an artisan at a time prior to the invention to provide a interactive wagering system that provides users with an option to record race videos while the user is interacting with a plurality of wager creation options in order to simplify to recording process thereby increase the quickly and easily designate a video for recording from an interactive display. *See Lawler, col. 1:45-50.*

Third, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case the applicants arguments that *Brenner '211*, *Brenner '068* or *Lawler* individually fail teach the a user interacting with wager creation option wherein the interactive wagering automatically provide the user with the option to record a given race is unpersuasive because the rejection is based on the combination of references. *See supra*.

Art Unit: 3714

Fourth, in regard to claims 19 and 48, the Applicant argues that the prior art does not teach the claimed feature of automatically providing the user with the option to record a race in response to the user placing a wager on the race. The examiner respectfully disagrees.

Again, the standard of patentability is what the prior art taken as a whole at a time prior to the invention suggests to an artisan. *See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981)*. As discussed above, *Brenner '211* and *Brenner '068* disclose off-track wagering systems having an interactive, menu-based user interface allowing users to selectively view race information, place wagers, view race videos from remotely located terminals through an interactive menu. *Lawler* discloses an analogous interactive system in which a user interacts with a terminal displaying menu options on a monitor to select program options including automatically providing the option to record a video upon selection. *See fig. 1, 4-10; col. 7:10-18; 10:42-11:6*. More specifically, when a user selects a menu option, the system will automatically offer the user the option to record the program. *See id.* *Lawler* provides a system that simplifies recording video programs through an interactive, menu-based user interface by automatically providing the option to record videos upon selection by the user. *See fig. 1, 4-10; col. 1:33-2:35, 7:10-18; 10:42-11:6*. Thus, *Lawler* suggests to an artisan to automatically provide users the option to record a video program when they select content from an interactive menu displayed on a monitor to simplify the recording process. *See id.*

Thus, in this case the combination of *Brenner '211* and *Brenner '068*, each with *Lawler*, when taken as a whole, suggests to an artisan at a time prior to the invention providing the user with the option to record a race in response to the user placing a wager on the race to simplify the process of recording video programs.

In conclusion, for the reason given above, the rejection of claims 1-19, 37-48 under the judicially created doctrine of obviousness-type double patenting is maintained. The nonstatutory double patenting

Art Unit: 3714

rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3714

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9302 for regular communications and 703 872 9303 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.

S.A.
December 10, 2002

A handwritten signature in black ink, appearing to read 'MS', with a long horizontal line extending to the right.

MARK SAGER
PRIMARY EXAMINER